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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,733

12/01/2006

Gary Fenton

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27777 7590 04/10/2009  
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EXAMINER

LAWSON, MATTHEW JAMES

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

04/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,733	<b>Applicant(s)</b> FENTON ET AL.	
	<b>Examiner</b> MATTHEW LAWSON	<b>Art Unit</b> 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/27/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 , 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Petersen (US 5.548.837).

Petersen discloses disclose an instrument for positioning a cup component of an orthopedic joint prosthesis, having a shaft (81, figure 7), and a flange (see figure below) towards the end of the shaft on which the cup component (figure 7) can be fixed, which extends from the shaft transversely, and which can be retracted from an in-use position (column 7, lines 62-67 and column 8, lines 1-8 and 33-43) in which the flange can be received in a groove in the internal surface of the cup component, when positioned over the end of the instrument, and a retracted position (figure 7b) in which the flange is withdrawn towards the axis of the shaft from the in-use position, allowing the cup component (see figure below) to be released from the instrument, in which the instrument includes a transverse support (see figure below) which extends generally parallel to the flange, and in which the flange comprises at least two radially spaced apart flange portions (see figure below), at least one of the flange portions being retractable as specified above while being supported by the support, the movement of the retractable flange portion between the retracted and in-use positions being in a

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direction which is parallel to the support, the retractable flange portion being biased towards the in-use position (column 8, lines 9-16 and 33-43) by means of a spring element (107, figure 8) which is made of a non-metallic material other than the flange portion (column 5, line 57), and the flange being made of a non-deformable metal (column 8, lines 6-7). The instrument further has a pair of opposite support surfaces (see figure below) which the side of the retractable flange portion facing towards the end of the instrument can slide against. The spring element further is positioned between the flange portion and the axis of the shaft and is compressed elastically by the by the flange portion when the portion is move from its in-use position towards its retracted position (column 7, lines 62-67 and column 8, lines 1-8 and 33-43), the spring element being an O-ring which is positioned between the retractable flange portion and the shaft (column 5, line 57). The face of the flange which faces towards the end of the shaft is chamfered at its edge (column 7, lines 65-67), and the cup component being a cup component of a joint prosthesis (column 2, lines 48-49).

Rehmann et al. disclose an instrument for positioning a cup component of an orthopedic joint prosthesis, having a shaft (see figure below), and a flange (see figure below) towards the end of the shaft on which the cup component (see figure below) can be fixed, which extends from the shaft transversely, and which can be retracted from an in-use position (figure 2) in which the flange can be received in a groove in the internal surface of the cup component, when positioned over the end of the instrument, and a retracted position (figure 3) in which the flange is withdrawn towards the axis of the shaft from the in-use position, allowing the cup component to be released from the instrument, in which the instrument includes a transverse support (see figure below)

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which extends generally parallel to the flange, and in which the flange comprises at least two radially spaced apart flange portions (figure 4), at least one of the flange portions being retractable as specified above while being supported by the support, the movement of the retractable flange portion between the retracted and in-use positions being in a direction which is parallel to the support, the retractable flange portion being biased towards the in-use position. The support presents a pair of opposite support surfaces (see figure below) and the retractable flange portion slides between them, and the support presents a support surface which the side of the retractable flange portion facing towards the end of the instrument can slide against (figures 2 and 3). The device has at least three radially spaced apart flanges (figure 4) and a cup component of a joint prosthesis (see figure below).

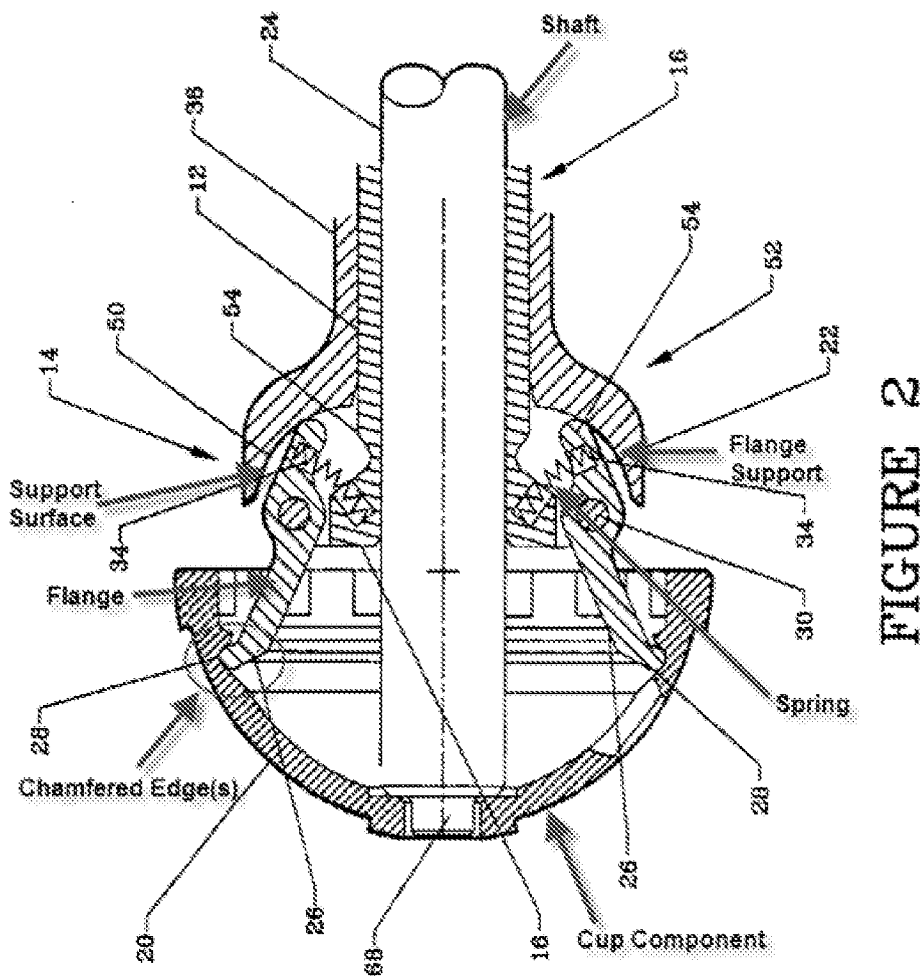


FIGURE 2

**Claim Rejections -****35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen (US 5,584,837) in view of Cohen et al. (US 5,571,200).

Petersen discloses the claimed invention except for the instrument having a soft

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cap positioned between the flange and the end of the shaft and which at least partially surrounds the end of the shaft.

Cohen et al. disclose an instrument for positioning a cup component of an orthopedic joint prosthesis, having a soft cap (60, figures 7a-7b) which is positioned between the flange and the end of the shaft and is at least partially surrounded by the end of the shaft to create an interference fit between the cup (column 5, lines 22-29). Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the device of Petersen to have a soft cap to create an interference fit between the cup.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen (US 5,584,837) in view of Schroeder (US 6,132,469).

Petersen discloses the claimed invention except for the instrument including a plate which is fixed relative to the shaft with the flange between the plate and the end of the shaft for engaging the open mouth of the cup component to apply force to it in which the edge of the plate is chamfered so that its transverse dimension is greatest about the surface which contacts the cup component.

Schroeder discloses an instrument for positioning a cup component of an orthopedic joint prosthesis, having including a plate (111, figures 6-7, and 17-19) which is fixed relative to the shaft with the flange (115, figures 6-7, and 17-19) between the plate and the end of the shaft for engaging the open mouth of the cup (41, figures 17-19) component to apply force to it (column 4, lines 52-55) in which the edge of the plate

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is chamfered so that its transverse dimension is greatest about the surface which contacts the cup component to provide for an even and peripherally uniform load distribution upon the shell (column 4, lines 58-60). Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the device of Petersen to have a plate fixed relative to the shaft with the flange to provide for an even and peripherally uniform load distribution upon the shell.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **See Attached PTO-892.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW LAWSON whose telephone number is (571)270-7375. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MATTHEW LAWSON/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775